

REMARKS

The last Office Action dated 11/12/ 2004 has been carefully considered. In response to the Examiner's objection to claim 2, this issue should be resolved with the amendment of claim 2.

It is noted that **Claims 2-3, 6-8** are rejected under 35 U.S.C. §103(a) as being unpatentable over Hutchinson (U.S. 5,482,373) in view of Ort. (U.S. 5,867,848).

It is further noted that **Claims 2-4 and 6-8** are rejected under 35 U.S.C. §103(a) as being unpatentable over Hutchinson (U.S. 5,482,373) in view of Williams (U.S. 5,809,590)

It is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness. The Examiner has the burden to indicate with specificity the teaching, suggestion or motivation to combine the elements in the cited references, as stated in *McGinley v. Franklin Sports Inc.*, 262 F.3d 1339, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) which held that "The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some "teaching, suggestion or reason" to combine cited references. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). When the art in question is relatively simple, as is the case here, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously."

The Courts have emphasized and amplified on this rule in numerous decisions, for example see *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50

USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined *only* if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is respectfully submitted that the Examiner has not applied the criteria rigorously, as there is not suggestion in Ort or Williams that the thermochromic ink, which undergoes a transparent to opaque transition, be used to indicate the actual temperature of a fluid container within a beverage container, as claimed by the Applicant. Ort and Williams do not teach the use of thermochromic ink to display the temperature of a fluid, but merely to activate advertising slogans, taking advantage of the temperature difference between urine and cool tap water. As the thermochromic display of Ort and Williams comes into direct contact with the water or urine, the Examiner has failed to show any teaching or motivation to use a thermochromic ink of this type on the exterior of a beverage container, where it would not make actual contact with the warm beverage fluid.

Thus, the Examiner's statement on page 4, paragraph 3 of the Office Action is merely states a conclusion as what would have been obvious, as it simply states the claimed combination without supplying a motivation to make the combination. It cannot be said to meet the legal standard set forth in *McGinley v. Franklin Sports Inc.*, *Gambro Lundia AB v. Baxter Healthcare Corp.*, *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, *In re Dembicza*k, *In re Dance*, or *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, *supra*.

Further, it is respectfully submitted, *in arguendo*, that even if the Examiner could

establish a *prima facie* case of obviousness the combination of either Williams or Ort with the Hutchinson reference is improper, as neither Ort nor Williams are analogous art under the authority of *In re Wood*, 599 F.2d 1032, 202 USPQ 171, 174 (C.C.P.A. 1979) has held that “In resolving the question of obviousness under 35 U.S.C. § 103, we presume full knowledge by the inventor of all the prior art in the field of his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved. The rationale behind this rule precluding rejections based on combination of teachings from references from non-analogous arts is the realization that an inventor could not possibly be aware of every teaching in every art. Thus, we attempt to more closely approximate the reality of the circumstances surrounding the making of an invention by only presuming knowledge by the inventor of prior art in the field of his endeavor and in analogous arts.

The determination that a reference is from a nonanalogous art is therefore two-fold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.”

Thus, application of the first step in determining if either the Ort or the Williams patents are analogous art fails, as it cannot be reasonably said that they are within the applicant's field of endeavor. The Applicants field of endeavor is tableware, and in particular, containers for serving warm beverages. Ort and Williams filed of endeavor is displaying advertising in urinal fixtures in public restrooms.

Further, the second step also fails, as it cannot be reasonably said that either Ort or Williams is reasonably pertinent to the Applicants particular problem, which is finding a simple way of indicating the temperature of the beverage in a vessel used for its consumption.

Ort and Williams do not teach the indication of temperature, but rather a method for activating advertising materials. Further, the thermochromic ink used by Ort and Williams would not be of interest to one seeking to indicate temperature because it

operates in a different temperature range by a different method. Ort and Williams use a transparent ink that operates between what is reasonably understood to be somewhat below tap water temperature, which is somewhat less than room temperature, perhaps 50 to 70 degrees F, and the body temperature of 98.6 degrees. In contrast, the Applicant's invention must function at the much higher temperatures desired of warm beverages, that is circa 40 degrees C (104 degrees F) and 140 degrees F.

In addition, the thermochromic ink of Ort and Williams is activated by direct contact with the fluid, flushing water or urine, whereas the Applicant's thermochromic ink is activated by conduction of heat first from the fluid to the walls of the beverage container, and then from the beverage container to the thermochromic ink, including heating of an adhesive used to apply the indicator. Accordingly, the thermochromic ink of Williams and Ort operates in such a different manner (direct contact with the fluid), to provide a different result (display of advertising matter) by a different method (sensing the temperature change between urine and tap water) that it cannot be considered at all pertinent to the Applicants objective of indicating the suitably of a warm beverage for consumption.

Accordingly, as the Examiner has failed to meet the burden of establishing a *prima facie* case with the art cited, and such art is not sufficiently analogous to be cited in an obviousness rejection against the applicant, the rejection of Claims 2-8 was improper. The Applicant hereby requests that the rejection be withdrawn and the application be allowed to pass to issue.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, she is invited to telephone the undersigned.

Respectfully submitted:

By 

on 1/24/2005

Edward S. Sherman, Ph.D.,
Patent Attorney (Reg. No. 43,115)
3354 Round Barn Boulevard
Suite 303
Santa Rosa, CA 95403
707)539-7680
707)332-3645 (mobile)
707)528- 6015 (fax)